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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/657,022	09/05/2003	John J.L. Simard	MANNK.032A	1687
20995 7590 01/11/2007 KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614			EXAMINER SCHWADRON, RONALD B	
			ART UNIT	PAPER NUMBER
			1644	
SHORTENED STATUTORY PERIOD OF RESPONSE		NOTIFICATION DATE	DELIVERY MODE	
3 MONTHS		01/11/2007	ELECTRONIC	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 01/11/2007.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/657,022

Applicant(s)

SIMARD ET AL.

Examiner

Ron Schwadron, Ph.D.

Art Unit

1644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _____ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1. Applicant's election with traverse of Group I and the peptide of SEQ. ID. No 67 in the reply filed on 12/11/06 is acknowledged. The traversal is on the ground(s) that are stated. This is not found persuasive because of the following reasons. Regarding applicants comments, Groups I-IV are distinct for the reasons elaborated in the previous Office Action. Regarding applicants comments about serious burden, the M.P.E.P. § 803 states that: "For purposes of the initial requirement, a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation either separate classification, separate status in the art, or a different field of search". The restriction requirement enunciated in the previous Office Action meets this criterion and therefore establishes that serious burden is placed on the Examiner by the examination of

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 17,27,30-32,34-39 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 12/11/06. It is noted that claim 33 is included as per reading on a composition containing a peptide, whilst claims 17 and claim 27 read on nucleic acids.

3. Applicant is required to amend the claims to delete nonelected inventions (aka remove the nucleic acids from claim 1).

4. Applicant is required to update the status of all US applications disclosed in the instant invention.

5. The disclosure is objected to because it contains an embedded hyperlink on page 38 and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

6. Claims 1-16,18-26,28,29,33,40 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification does not provide adequate written description of the claimed invention. The legal standard for sufficiency of a patent's (or a specification's) written description is whether that description "reasonably conveys to the artisan that the inventor had possession at that time of the...claimed subject matter", *Vas-Cath, Inc. V. Mahurkar*, 19 USPQ2d 1111 (Fed. Cir. 1991). In the instant case, the specification does not convey to the artisan that the Applicant had possession at the time of invention of the claimed invention.

The instant claims encompass polypeptides having "substantial similarity" to those disclosed in Table 1B and polypeptides having "functional similarity" to said peptides. Thus, the claims encompass a vast array of mutant peptides that are not disclosed in the specification and wherein it is unpredictable as to what peptides would have the aforementioned attributes and be functionally active for the various uses of said peptides disclosed in the specification. Karin et al (*J. Exp. Med.* 180: 2227-2237, 1994) teach that amino acids in an MHC binding peptide that are not the amino acids which participate in MHC binding can have a profound effect on whether or not a peptide is immunogenic. Karin et al teach that a single substitution in an amino acid, wherein said amino acid plays no role in MHC binding can completely abrogate the immunogenicity of an otherwise immunogenic peptide (especially Summary and Table 1). Thus Karin et al establish that it is unpredictable as to what amino acid residues not involved in MHC binding of a peptide can be changed wherein the peptides remain immunogenic.

In view of the aforementioned problems regarding description of the claimed invention, the specification does not provide an adequate written description of the invention claimed herein. See *The Regents of the University of California v. Eli Lilly and Company*, 43 USPQ2d 1398, 1404-7 (Fed. Cir. 1997). In *University of California v. Eli Lilly and Co.*, 39 U.S.P.Q.2d 1225 (Fed. Cir. 1995) the inventors claimed a genus of

DNA species encoding insulin in different vertebrates or mammals, but had only described a single species of cDNA which encoded rat insulin. The court held that only the nucleic acids species described in the specification (i.e. nucleic acids encoding rat insulin) met the description requirement and that the inventors were not entitled to a claim encompassing a genus of nucleic acids encoding insulin from other vertebrates, mammals or humans, *id.* at 1240. In the instant case, the facts are similar to those disclosed in *University of California v. Eli Lilly and Co.* The Federal Circuit has held that if an inventor is "unable to envision the detailed constitution of a gene so as to distinguish it from other materials. . . conception has not been achieved until reduction to practice has occurred", *Amgen, Inc. v. Chugai Pharmaceutical Co, Ltd.*, 18 U.S.P.Q.2d 1016 (Fed. Cir. 1991). Attention is also directed to the decision of *The Regents of the University of California v. Eli Lilly and Company (CAFC, July 1997)* wherein is stated: The description requirement of the patent statute requires a description of an invention, not an indication of a result that one might achieve if one made that invention. See *In re Wilder*, 736 F.2d 1516, 222 USPQ 369, 372-373 (Fed. Cir. 1984) (affirming rejection because the specification does "little more than outlin[e] goals appellants hope the claimed invention achieves and the problems the invention will hopefully ameliorate."). Accordingly, naming a type of material generally known to exist, in the absence of knowledge as to what that material consists of, is not a description of that material. Thus, as we have previously held, a cDNA is not defined or described by the mere name "cDNA," even if accompanied by the name of the protein that it encodes, but requires a kind of specificity usually achieved by means of the recitation of the sequence of nucleotides that make up the cDNA. See *Fiers*, 984 F.2d at 1171, 25 USPQ2d at 1606.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-16,18-26,28,29,33,40 are rejected under 35 U.S.C. 102(b) as being anticipated by Fikes et al. (WO 01/45728).

Fikes et al. teach the peptide of SEQ. ID. 67 (see pages 237, 240 and Table 24). The peptide is 10 amino acids long. The various functional activities of the peptide recited in the claims are inherent properties of said peptide. Applicant has indicated that the elected species reads on all of the claims currently under consideration (see page 6, fourth paragraph of the response filed 12/11/06). The recitation of a method of determining the binding affinity carries no patentable weight in the instant product claims. The peptide can have added amino acids (see claim 2 of Fike et al.) at the N-terminus (see page 16, line 5). Fikes et al. teach analogs of said peptides (see page, last paragraph). Fikes et al. teach a composition of said peptide and an excipient (see claim 24) and a method of making said vaccine (see page 31). Fikes et al. teach a composition of said peptide with a pAPC (dendritic cell) and/or GM-CSF (see pages 32-33). Fikes et al. teach a cell that expresses the claimed peptide and contains a CpG polynucleotide and/or nucleic acid encoding an adjuvant such as GM-CSF (see page 35, last two paragraphs, and page 36, penultimate paragraph). The composition can contain a second epitope (see page 32). The composition can contain multiple copies of the peptide wherein as per above applicant has indicate that the elected species reads on all of the claims under consideration (aka said peptide has the property of claim 13 or 16).

9. No claim is allowed.


10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ron Schwadron, Ph.D. whose telephone number is 571 272-0851. The examiner can normally be reached on Monday-Thursday 7:30-6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on 571 272-0841. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1644

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Ron Schwadron, Ph.D.
Primary Examiner
Art Unit 1644



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